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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/714,178

11/17/2003

Luc Orino

550-477

9349

23117 7590 11/26/2010  
NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER

HOANG, DANIEL L

ART UNIT

PAPER NUMBER

2436

MAIL DATE

DELIVERY MODE

11/26/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/714,178             | ORINO ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | DANIEL L. HOANG        | 2436                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments, see Pre-Brief conference request filed 6/30/10, with respect to the rejection(s) of claim(s) 1-7, 10-17 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a Double Patenting rejection has been made below.

### ***Double Patenting***

1. Claims 1-7, and 10-17 of this application conflict with claims 1-3, 5-16, and 18-23 of Application No. 10714480. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-7, and 10-17 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 5-16, and 18-23 of prior U.S. Patent No. 7231476. This is a double patenting rejection.

|         | Application No. 10/419,491  | Application No. 10/419,490   |
|---------|---|--|
| Claim 1 | <p>A processor operable in a plurality of modes, and a plurality of domains, said plurality of domains comprising a first domain and a second domain, the processor comprising:</p> <p>monitoring logic configured to perform a debug or trace function to monitor said processor and to capture diagnostic data in response to performing said debug or trace function;</p> <p>a storage element operable to contain at least one control parameter;</p> | <p>A processor operable to perform a plurality of functions, said processor comprising:</p> <p>wherein said processor being operable in a plurality of modes and a plurality of domains said plurality of domains comprising a first domain and a second domain, and said processor further comprising:</p> <p><i>[see claim 1]</i></p> <p>monitoring logic operable to perform a diagnostic function and capture diagnostic data from said processor;</p> <p><i>[see claim 1]</i></p> <p>wherein said monitoring logic comprises logic operable to perform a debug function <i>[see claim 6]</i></p> <p>a storage element operable to receive and to store an input signal input via said input port, said input signal comprising at least one control value; <i>[see claim 1]</i></p> |

|  |  |   |
|--|--|---|
|  | <p>control logic operable to control said monitoring logic in dependence on said at least one control parameter and the domain in which said processor is operating to suppress capturing of diagnostic data relating to predetermined activities of said processor in said first domain while allowing capturing of diagnostic data relating to predetermined activities of said processor in said second domain.</p> | <p>access logic operable to receive an access control signal and to disable access via said input port to said at least one control value stored in said storage element in dependence upon said access control signal, wherein said control value is indicative of whether said diagnostic function is available to capture diagnostic data from said first domain; and</p> <p><i>[see claim 1]</i></p> <p>wherein said first domain is a secure domain and said second domain is a non-secure domain, said processor being operable such that when executing a program in a secure mode within said secure domain said program has access to secure data which is not accessible when said processor is operating in a non-secure mode in said non-secure domain.</p> <p><i>[see claim 5]</i></p> |
|--|--|---|

Note the comparison above, claim 1 of the instant application 10714178 is not patentably distinct from claims 1, 5 and 6 of copending application 10714480.

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Claims 2-7, and 10-17 are similarly rejected as not being patentably distinct from claims 2-3, 5-16, and 18-23 of copending application 10714480, as they have the same subject matter as discussed for claim 1 above.

\*. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulaney Street  
Alexandria, VA 22314

\*. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel L. Hoang/

Examiner, Art Unit 2436

Art Unit: 2136

/Nasser Moazzami/

Supervisory Patent Examiner, Art Unit 2436